

blocking position and an unblocking position while inhibiting the first door panel from rotating about a vertical axis; and

at least one backup plate interposed between the resilient core and the flexible covering, wherein the at least one backup plate has a rigidity greater than that of the resilient core and the flexible covering.

### REMARKS

The applicants have carefully considered the Office action dated March 29, 2000 and the references it cites. By way of this Response, new claims 29-37 have been added for completeness; and claims 1-3, 10 and 15 have been amended for clarity. In view of the following, it is respectfully submitted that all pending claims are in condition for allowance and favorable reconsideration is respectfully requested.

As an initial matter, applicants note that claims 21-28 stand allowed and are not further addressed herein.

Claim 10-15 were also indicated as allowable by the Office action. Accordingly, applicants have rewritten claims 10 and 15 in independent form to include the recitations of claim 1 with one broadening amendment. In particular, the flexible covering is recited as "at least partially" covering the resilient core in claims 10 and 15. Claim 15 has also been amended to correct the antecedent basis informality noted in the action. Accordingly, claims 10

and 15, as well as all claims depending therefrom are in condition for allowance.

Claims 1-9, 16-20 and new claims 29-37 remain at issue.

The Office action rejected claims 1-9 and 16-20 as being unpatentable over one or more of Clark, U.S. Patent 2,878,532, Suter, U.S. Patent 3,675,377 and Saucier, U.S. Patent 4,083,148. Applicants respectfully traverse these rejections.

Claim 1 recites a combination including a door panel which is at least thickness compressible, but nonetheless is able to transmit a compressive load in a direction within the plane of the panel having a magnitude below a first threshold without appreciable distortion. None of the cited art, whether taken alone or in combination teaches or suggests such a door.

For example, Clark, the primary reference relied upon in the action appears to disclose a rigid door panel. There is nothing in Clark to suggest that the described door is thickness compressible. Indeed, the unnumbered end panels between face panels 9 and 10 shown in FIG. 4 suggest the contrary; that the rigid face panels are rigidly separated and not thickness compressible. Therefore, Clark does not teach or suggest the combination of claim 1.

Although the Suter reference discloses an inflatable structural component that is presumably thickness compressible, there is no legally proper suggestion for combining the Suter structure with the Clark structure.

As explained by the Federal Circuit:

As this court has stated, “virtually all [inventions] are combinations of old elements.”

Therefore, an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability." To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

In re Rouffet, 47 U.S.P.Q.2d 1453, 1457 (Fed. Cir. 1998)(citations omitted and emphasis added).

Here the Office action has failed to identify the necessary suggestion for combining the prior art references in the proposed manner. Instead, the Office action has merely identified a beneficial result of making the proposed combination of art and then argued that, given the beneficial result, it would be obvious to make the combination. Such an approach is legally impermissible. A beneficial result cannot constitute a legally permissible suggestion for making a combination. Specifically, it is indisputable that every time the PTO examines a claim to a combination of old elements, there will always be a

beneficial result to combining those old elements or no applicant would ever apply for patent protection for that claimed combination. Therefore, it is always possible to reject every possible combination of old elements as obvious based on the “beneficial result” approach followed in the Office action. Indeed, were the approach followed by the Office action permissible, no combination of old elements could ever be found patentable; a result that is clearly at odds with the Federal Circuit’s acknowledgment that nearly every invention is a combination of old elements. Accordingly, applicants respectfully traverse all of the rejections made on the “beneficial result” approach followed in the Office action as being unsupported by a legally proper suggestion for making the alleged combinations and, thus, are improper as a matter of law.

The Office action failed to identify a legally permissible suggestion for combining Clark and Suter, because none exists. As discussed above, Clark discloses a rigid panel door that defines an interior space to receive insulation material. The door is, therefore, particularly adapted for use on a cold storage locker. The Suter reference discloses an inflatable structural component. There is no disclosure that Suter would be useful as a door, much less as a door on a cold storage compartment. Accordingly, there is no apparent reason that a person of ordinary skill in the art would be lead to substitute the inflatable structure of Suter for the insulated cold storage door of Clark. Indeed, as the record stands now, the only possible suggestion for taking such

an action lies in applicants' own disclosure, which is, of course, a legally impermissible source of inspiration for recreating applicants' claimed combination.

Moreover, even if there were a legally permissible suggestion for combining Suter and Clark, one would still not arrive at the combination of claim 1. In particular, it appears that the rejection contemplates completely eliminating the Clark rigid panel door and using the Suter structure in its place. However, nothing in Suter suggests that the Suter structure can transmit in a direction within the plane of the structure a compressive load having a magnitude below a first threshold without appreciable distortion to the structure as recited in claim 1. Therefore, even if one were to combine the Suter and Clark structures, one would not arrive at the combination recited in claim 1. Since the Saucier disclosure adds nothing to this analysis, applicants respectfully submit that claim 1 and all claims depending therefrom should be allowed.

New independent claim 36 should also be allowed. Claim 36 recites a door comprising a resilient core which is vertically compressible by a force in a direction within the plane of the door panel and is further able to recover its relaxed shape after the force is either reduced or removed. As no such structure is taught or suggested by any legally permissible combination of the cited art, claim 36 should be allowed.

New claim 37 should also be allowed. Claim 37 is a broadened version of allowable claim 10, but it replaces the term "a plurality of backup plates" with the term "at least one backup plate".

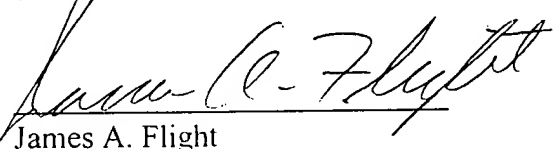
Lastly, applicants note that this Response has made various clarifying amendments throughout the claims. As demonstrated by the fact that applicants did not argue any of these changes to the Office to distinguish the cited art, those claim amendments were not necessary for patentability but were instead effected to increase the clarity and readability of the claims. There is no intention to limit the scope of equivalents to which any of the pending claims are entitled under the Doctrine of Equivalents by way of such claim amendments.

If the Examiner is of the opinion that a telephone conference would expedite the prosecution of this case, the Examiner is invited to contact the undersigned at the number identified below.

Respectfully submitted,

MARSHALL, O'TOOLE, GERSTEIN,  
MURRAY & BORUN  
6300 Sears Tower  
233 South Wacker Drive  
Chicago, Illinois 60606-6402  
(312) 474-6300

By:

  
James A. Flight  
Registration No. 37,622

September 25, 2000

455741

## METHOD OF PAYMENT

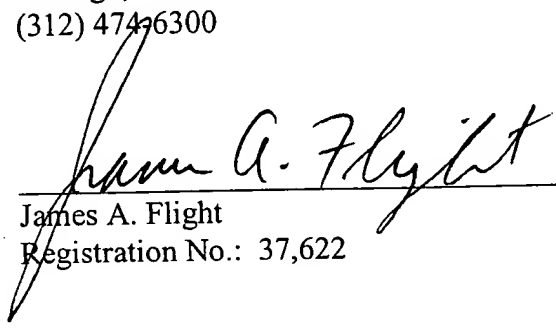
Attached is a check in the amount of \$1,584.00 (\$240.00 in payment of the fee for late submission of an information disclosure statement; \$474.00 additional claims fee; and \$870.00 in payment of a three month extension of time fee).

The Commissioner is authorized to charge any fee deficiency required by this paper, or credit any overpayment, to Deposit Account No. 13-2855. A copy of this paper is enclosed.

Respectfully submitted,

MARSHALL, O'TOOLE, GERSTEIN,  
MURRAY & BORUN  
6300 Sears Tower  
233 South Wacker Drive  
Chicago, Illinois 60606-6402  
(312) 474-6300

By:

  
James A. Flight

Registration No.: 37,622

September 25, 2000

456964